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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,493	07/30/2003	David Leigh Trigg	AA-541MC	9684

27752 7590 10/05/2007
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EXAMINER

GEMBEH, SHIRLEY V

ART UNIT	PAPER NUMBER
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1614

MAIL DATE	DELIVERY MODE
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10/05/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/630,493

Applicant(s)

TRIGG ET AL.

Examiner

Shirley V. Gembel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 21-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The response filed **7/13/07** presents remarks and arguments to the office action mailed **5/15/07**. Applicant's request for reconsideration of the rejection of claims in the last office action has been considered.

Applicant's arguments have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Status of claims

Claims 1-27 are pending.

Claims 1-20 are examined in this office action and claims 21-27 are withdrawn by restriction election practice.

Maintained Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "from about", "at least about" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, one of ordinary skill in the art would not be reasonably apprised of the scope of the invention, because one of skill will not be able to determine which term is in control. The claims lack clarity as to whether "from" (a lower limit) or "about"(broadening limitation, both higher and lower) controls the metes and bounds of the phrase "from about". Regarding "at least" (a lower limit) or about "(broadening limitation, both higher and lower), it is unclear what controls the metes and bounds of the phrase "at least about".

Applicant argues that the rejection should be withdrawn and that the terms serve as approximation and is clear to one of ordinary skill in the art.

This is found unpersuasive because "from about" is vague and indefinite and the explanation above is explicitly stated.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims **1-11, and 17 -19** remain rejected under 35 U.S.C. 103(a) as being unpatentable over Ha et al., US 5,997,887, taken with Jacquier, US 6,337,066, and Okamura, EP 0063875, in view of Masuda et al., US 4, 076, 663, taken with Bengs et al., US 6,548,075 and Zatz et al., J. Pharmaceutical Science (Abstract Only).

Ha et al. teach a liquid composition comprising a water insoluble substrate (see col. 18, lines 35-38) as a lipid or oily material. Oils are hydrophobic in nature and are commonly known to one of ordinary skill in the art as water insoluble. Ha et al. teach a reflective particulate material, wherein the reflective particulate has a particle size of 100 nm (see col. 3, lines 5-10), a water soluble thickening agent wherein the thickening agent is xanthan gum, as in claims 1 and 6 (see col. 11, lines 26-27). Xanthum gum is used as a non-gelling agent for controlling viscosity and has a very high –low sheer viscosity (as evidenced by Zatz et al. see abstract) and is a polymeric thickening agent. According to s evidence by Zatz et al. the viscosity of xanthan is 10^{-3} to 3.3×10^{-3} thus is within the claim limitation. Also, the Ha et al. reference teach the viscosity value is 1

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cps = 0.001 Pa·s = 1 mPa·s and the viscosity of these thickening agent is 50-70,00 cps, which is within the instant claim limitation having a viscosity of 1000mPa.s-700,000 (see col. 11, lines 40, 56-60 and col. 18 lines 65-67). Further, see column 5, lines 26-27, where the aqueous carrier is water. The skin tone changing agent is about 0.01 %-2% falls within the limitation of claim 2 see col. 3, lines 6-8 and has having a particle size of 100 nm (see col. 3, line 8), as in claims 3 and 4. The particulate material is a metallic oxide (see col. 3, line 15).

The reference also teaches the mask composition contains vitamin C (ascorbic acid (see col. 27, lines 63-64) and vitamin B₃ (see col. 25, lines 65-67), as in the current claim 8, a humectant (see col. 24, lines 1-2), as in the instant claim 9, as a moisturizing agent. One of ordinary skill in the art would have been motivated to add a humectant to the composition because it adds moisture to the skin and does not leave the skin dry after the mask is removed. With regard to claim 5, the reference teaches starch is condensed with long chain alcohol to form resistant starch (see col. 19, lines 39-41), wherein the C8-30 having a sugar moiety (see col. 19, lines 40-42) connected via an ether linkage on the other end with a fatty alcohol to aid in dispersing the one phase (discontinuous) to the other phase (continuous) is disclosed as a dispersion characteristics. (Note this is a non-starch polysaccharide). Therefore, one of ordinary skill in the art would have been motivated to use such a starch that would not only bind the components together but will also protect the face. The reference uses starch polymers (see col. 19, lines 39-41), such as glycosides. By definition, resistant starch is defined as starch that is not absorbed in the small intestine. Note that polyglycosides

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are formed by linking the carbohydrate moiety by $\alpha(1\rightarrow4)$ bonds. Therefore, the starch used in the reference is a resistant starch (see explanation of a resistant starch above). Resistant starches are not digested in the small intestine but pass to the large bowel for fermentation a non-starch polysaccharide (see abstract), as evident by Nils-Georg Asp (1987, vol. 9 (1) Abstract only). The reference is supplied as evidence only.

Jacquier teaches the use of resistant starch under the name resistamyl-E2 (see col. 2, line 42), as required by instant claim 5, in a cosmetic formulation for treating skin. One of ordinary skill in the art would have been motivated to use a resistant starch in a mask because Jacquier teaches its conventional use in a cosmetic formulation.

Okamura teaches a cosmetic face mask having a water-insoluble substrate that is made of a non-woven material (see page 5, lines 15-18), such as cotton yarn, synthetic material, as in claims 1 and 11. The reference also teaches a water-insoluble substrate that is configured to cover the majority of the facial area (see first page of the reference diagram), as in claims 17 and 19, as a single piece (see diagram). The reference also teaches (see page 7, lines 1-10) other agents or components that are included in the mask, such as a humectant. With regard to claim 18, the specific dimension is not taught, but the reference teaches paper. Paper falls within the claim limitation of 18 (see pg. 5, lines 5-10) having a thickness from 100 μm to 1 cm.

Bengs et al. teach polysaccharide products in cosmetics (see col. 1, lines 22-50). These polysaccharides have been used to treat skin to produce a pleasant feel (see col. 1, lines 49 and col. 10, lines 9-24). Note that Ha et al. teach the formation of these non-starch polysaccharides.

Although the Ha et al. reference does not teach a water-insoluble substrate, as cotton yarn or rayon material, as in claims 1 and 11, one of ordinary skill in the art would have been motivated to substitute the oily or lipid base of Ha et al. with the cotton yarn of Okamura, based on the end-product sought, and combine Okamura with the teachings of Bengs et al. Okamura further teaches that these face masks can be used without washing the face. Leaving flakes on the face (see page 7, line 20-30). opens sweat glands, depending on the material used (as a hot pack), gives a high refreshing effect (see page 8, lines 1-20) and can be used for a wide range of applications. For example, if the facial mask is used to unclog the pores, reduce puffiness or replace moisture back to the skin, one of ordinary skill in the art would have been motivated to use a facial mask that has a water insoluble substrate as cotton yarn or rayon material that has embedded into it a liquid composition. When applied to the face, it adheres and dries and can be peeled off easily without making a mess or flakes to unclog pores, reduce swelling or puffiness and replace moisture. As evidenced by the cited prior art, adding perfume to the composition, as taught by Masuda et al., will maintain their effects for a longer time when the resins are impregnated with them, especially with the use of agricultural product (see col. 5, line 65 bridging col. 6, lines 1-2). One of ordinary skill in the art would have been motivated to combine the above cited references to achieve the claimed subject matter, because where Ha did not teach the resistant starch explicitly, Jacquier does. Both Ha and Okamura teach a humectant, and where Ha fails to teach a water-soluble, agent as a single piece, Okamura does.

Thus one of ordinary skill in the art would have been motivated to prepare have a mask comprising a water-insoluble substrate, a liquid composition a water-soluble thickening agent for consistency and an aqueous carrier for the reasons already addressed above.

Applicant argues Ha et al. teach a liquid composition comprising a water in soluble substrate as a lipid or oily material. Claim are given their broadest reasonable claim interpretation. Applicant's claim interpretation of a water insoluble substrate differs. Further, Okamura teaches a cosmetic face mask- having a water- insoluble substrate that is made of a non-woven material (see page 5, lines 15-18), such as cotton yarn or synthetic material, as in claims 1 and 11. Based upon the end use, one of ordinary skill in the art would have been motivated to use the Okamura teaching and employ the mask composition, as described in claims 1 and 11. Individually addressing each reference for what it teaches will not hold for the above set forth rejection. Rather, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

A reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill in the art might reasonably infer from the teachings. (*In re Opprecht* 12 USPQ 2d 1235, 1236 (Fed Cir. 1989); *In re Bode* 193 USPQ 12 (CCPA) 1976). In light of the forgoing discussion, the Examiner concludes that the subject

matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a).

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Double Patenting

Claim 1 – 15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 - 13 of U.S. Patent Application No. **10622518**. Although the conflicting claims are not identical, they are not patentably distinct from each other. The reasons are as follows:

Both the claims of the co-pending applications and that of the instant application are to a mask composition, wherein the instant claims recite a mask composition comprising a hydrophobic –water-insoluble substrate which can be an oily substance, fabric, paper a thickening agent, an aqueous carrier. The copending application recites a mask composition comprising:

- (1) a water insoluble substrate; and
- (2) an emulsified liquid composition comprising:
 - (a) an oily component;
 - (b) a hydrophilic surfactant;
 - (c) a water-soluble thickening polymer that provides the liquid composition a viscosity of from about 500mPa-s to about 60,000mPa-s; and
 - (d) an aqueous carrier.

Since the term “comprising” is used, the claims are interpreted as having the components that are missing in any one of the claims. One of ordinary skill in the art

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would be motivated to modify the facial mask add or remove agent depending on the purpose.

The claims of the co-pending application is an obvious variation of the claims of the instant application.

In view of the foregoing, the copending application claims and the current application claims are obvious variations.

Applicant argues that the Office is seemingly arguing that the open-ended term "comprising" can be read to teach anything. Clearly this is not accurate. If it were accurate, any claim using "comprising" (which most patent claims use) could be read to teach virtually everything.

Applicant further argues the Office has failed to establish a *prima facie* ease of obviousness by not providing an adequate factual basis for the proposed modification to the '518 application.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application and co-pending application are claiming mask composition, and method of treating the facial skin using the mask composition. There is overlap with respect to the ingredients, i.e., a thickener, humectant, and whitening agent. The expression "comprising" and the expression "comprising" in the co-pending application render both sets of claims open to the inclusion of any number of additional active agents. The substrate claimed is same in both the applications.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

No claim is allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shirley V. Gembel whose telephone number is 571-272-8504. The examiner can normally be reached on 8:30 -5:00, Monday- Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SVG
9/19/07

A handwritten signature in black ink, appearing to be "J. J. J.", with a circular mark to the left.A handwritten signature in black ink that reads "Phyllis Spivack".

**PHYLLIS SPIVACK
PRIMARY EXAMINER**

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